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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,686	04/18/2001	David Boll	10006470-1	7844

7590 07/11/2006

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EXAMINER	
SORRELL, ERON J	

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/837,686	BOLL, DAVID	
	Examiner	Art Unit	
	Eron J. Sorrell	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-25 and 38-56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1,3-25,38-40,42-45,47-49,51-54 and 56* is/are rejected.

7)☒ Claim(s) *41,46,50 and 55* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1,3,4,9,10,13, and 38 are objected to because these claims all use the optional language "configured to," to recited claim limitations. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. The Examiner suggests amending the claims to positively recite the functions of the claimed elements.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,4-7,10-15,18-20,22-25,38,39,42-44, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Shih (U.S. Patent No. 6,504,626).

4. Referring to apparatus claim 1, and method claim 15, Shih teaches an apparatus for transferring commands (see figure 3), comprising:

a scanner (item 42, figure 3) including a first port (see cable connecting keyboard to scanner) configured to receive user entered keyboard commands directly from a keyboard, wherein the scanner is configured to perform a scanner function based on the keyboard commands received directly from the keyboard and a second port (see cable connecting items 42 and 64), wherein the first port and second port are coupled together through a communication bus (see lines 29-51 of column 2); and

control logic associated with the communication bus (see item 14 in figure 4), the control logic is configured to control the passage of keyboard commands over the communication bus (see lines 29-51 of column 2).

5. Referring to claim 56, Shih teaches a keyboard coupled to the first port (see figure 3).

6. Referring to apparatus claim 4, and method claim 18, Shih teaches the control logic is configured to detect the presence of commands from the keyboard (see item 74, figure 4).

7. Referring to apparatus claim 5, and method claims 19 and 20, Shih teaches the control logic routes commands from the keyboard to the computer (see lines 1-8 of column 3) and from the keyboard to the scanner (see lines 33-40 of column 3).

8. Referring to claim 6, Shih teaches keyboard enable logic associated with the control logic (see lines 59-64 of column 2).

9. Referring to apparatus claim 7, Shih teaches the keyboard enable logic instructs the control logic to route commands from the keyboard to a keyboard/scanner interface (see lines 5-64 of column 2).

10. Referring to claim 10, Shih teaches a keyboard/scanner interface configured to receive keyboard commands from the control logic and forward the keyboard commands to a processor of the scanner.

11. Referring to apparatus claim 11, and method claim 22, Shih teaches the keyboard commands correspond to an email address (see lines 10-14 of column 3).

12. Referring to claim 12, and method claim 23, Shih teaches the keyboard commands correspond to a facsimile address (see lines 23-26 of column 3).

13. Referring to claim 13, and method claim 24, Shih teaches a network interface module coupled to the keyboard/scanner interface, the network interface module configured to connect the image scanner to an external network (see lines 10-14 of column 3).

14. Referring to claim 14, and method claim 25, Shih teaches a document scanned by the scanner is electronically mailed over the external network (see lines 10-14 of column 3).

15. Referring to system claim 38, and method claim 42 Shih teaches a system (see figure 3), comprising:

a computer (item 64, figure 3);

a scanner coupled to the computer (item 42, figure 3); and

a keyboard coupled to the scanner (item 54, figure 3)

wherein the scanner is configured to receive keyboard commands from the keyboard and perform a function based on the keyboard commands even if the computer is powered off (see lines 43-46 of column 3, note Shih teaches the scanner and keyboard

don't need the computer in order to carry out command processing, so the scanner can receive commands and carry out the processing irrespective of the state of the computer).

16. Referring to system claim 39, and method claim 43, Shih teaches the scanner comprises a first port and a second port coupled via a communication bus and wherein the keyboard couples to the first port and the computer couples to the second port (see figure 3).

17. Referring to method claim 44, Shih teaches powering the keyboard by the scanner if the computer is powered off (see lines 43-46 of column 3).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 2,8,9,16,17,40,45,47-49, and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in view of Broedner et al. (U.S. Patent No. 5,812,796 hereinafter "Broedner").

20. Referring to claim 2, Shih fails to teach the communication bus is configured to pass the keyboard commands received by the scanner to a computer through the second port prior to the scanner performing a scanner function based on the keyboard commands.

Broedner teaches, in an analogous system, the above limitation (see lines 12-20 of column 18).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Shih with the above teachings of Broedner in order to allow commands to be sent to the host regardless of the status of the peripheral devices as suggested by Broedner (see lines 12-20 of column 18).

21. Referring to apparatus claims 8 and 9, and method claims 16 and 17, Shih fails to teach a power detector coupled to the communication bus, the power detector configured to detect a power signal from a computer and power supply logic configured

to supply power to the keyboard if the power detector fails to detect the power signal from the computer.

Broedner teaches, in an analogous system, the above limitation (see lines 14-36 of column 6, note each peripheral can supply power to the bus and each device can detect changes in the voltage level).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Shih with the above teachings of Broedner for the same reasons as mentioned above.

22. Referring to system claim 40 and method claim 45, Shih fails to teach that if the computer is not powered off, the computer being able to receive keyboard commands from the keyboard via the scanner even if the scanner is powered off.

Broedner teaches, in an analogous system, the above limitation (see lines 5-9 of column 3). Broedner teaches a system wherein peripheral devices such as scanners and keyboards (see lines 43-53 of column 2) are connected in series to a computer (see figure 3). Broedner teaches that the devices further down stream can receive data and commands even if an upstream device is not powered on (see lines 5-9 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Shih with the above teachings of Broedner in order to allow downstream peripheral devices to communicate with the host even if one of the upstream devices is not able to be used as suggested by Broedner (see lines 5-9 of column 3).

23. Referring to system claim 47, and method claim 51, Shih teaches, a system comprising:

a computer (item 64, figure 3);

a scanner coupled to the computer (item 42, figure 3); and

a keyboard coupled to the scanner (item 54, figure 3),

Shih fails to teach that if the computer is not powered off, the computer being able to receive keyboard commands from the keyboard via the scanner even if the scanner is powered off.

Broedner teaches, in an analogous system, the above limitation (see lines 5-9 of column 3). Broedner teaches a system wherein peripheral devices such as scanners and keyboards (see lines 43-53 of column 2) are connected in series to a computer (see figure 3). Broedner teaches that the devices further down stream can receive data and commands even if an upstream device is not powered on (see lines 5-9 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Shih with the above teachings of Broedner in order to allow downstream peripheral devices to communicate with the host even if one of the upstream devices is not able to be used as suggested by Broedner (see lines 5-9 of column 3).

24. Referring to system claim 48, and method claim 54, Shih teaches the scanner comprises a first port and a second port coupled via a communication bus and wherein the keyboard couples to the first port and the computer couples to the second port (see figure 3).

25. Referring to claim 52, Shih teaches if the scanner is powered on and the computer is powered off, performing a function by the scanner based on keyboard commands from the keyboard (see lines 43-46 of column 3).

26. Referring to method claim 49, and method claim 53, Shih teaches powering the keyboard by the scanner if the computer is powered off (see lines 43-46 of column 3).

Allowable Subject Matter

27. Claims 41,46,50, and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

28. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or suggest alone or in combination, that if both of the scanner and the computer are powered on, then controlling the computer using the keyboard by default, and selectively controlling the scanner based on user activated signals, in combination with the other recited claim limitations.

Response to Arguments

29. Applicant's arguments with respect to the independent claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J.

Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EJS
July 5, 2006

KIM HUYNH
SUPERVISORY PATENT EXAMINER
6/7/06